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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,282	09/21/2001	Brian Sagar	069918.00000	2554

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/889,282

Applicant(s)

SAGER

Examiner

Elizabeth M. Cole

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 57,59–118 is/are pending in the application.  
4a) Of the above claim(s) 74-80 and 105-112 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 57,59-73,81-104 and 113-118 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 57, 59, 61, 64-73, 113, 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02-043275 in view of Rizika et al, U.S. Patent No. 5,650,213 for the reasons set forth in paragraph 1 of the previous action.

3. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims 57, 59, 61, 64-73, 116-118 above, and further in view of Yoshida et al, U.S. Patent No. 4,985,484 as set forth in paragraph 2 of the previous action.

4. Claims 63, 60, 81-104, 114, 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims 57, 59, 61, 64-73, 116 above above, and further in view of WO 95/14248 as set forth in paragraph 3 or the previous action.

5. Claims 117-188 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims above, and further in view of JP 02300253. JP '275 does not teach employing a silane coupling agent. JP '253 teaches that silane coupling agents were art recognized equivalents to blocked isocyanate coupling agents in the art of forming ink compositions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a silane coupling agent as the coupling agent in the composition of JP '275,

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motivated by the teaching that silane coupling agents were known to be equivalents to the blocked isocyanate coupling agents disclosed in JP '275.

6. Applicant's arguments filed 4/13/05 have been fully considered but they are not persuasive. Applicant argues that one of ordinary skill in the art would not have been motivated to combine the teachings of JP '275 and Rizika because JP '275 discloses an ink which comprises an organic soluble resin while the Rizika ink is an emulsion.

However, this argument is not persuasive because the rejection does not combine the two ink compositions, but rather states that it would have been obvious to have employed the particular microspheres disclosed in Rizika in the ink composition of JP '275. Employing the microspheres of Rizika does not require changing the ink composition of JP '275 or combining the aqueous and organic inks of the two references, but only requires mixing the microspheres of Rizika into the ink composition of JP '275, motivated by the expectation that this would enhance the appearance of the ink. Applicant argues that there is no motivation to make the combination of the microspheres of Rizika into the ink of JP '275, but since appearance is an important factor in inks, adding the microspheres to the ink of JP '275 would have been obvious to one of ordinary skill in the art. Applicant also asserts that the combination would have rendered JP '275 unsuitable for its intended purpose, because the microbeads would degrade the sterilization of the product by blocking or reflecting UV light or other forms of radiant energy. However, there is nothing on the record to show that radiant energy was going to be used to sterilize the products of JP '275 or to show that the presence of

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microbeads in the printing ink on the packages would in fact have a deleterious effect on the sterilization of the packages.

7. Applicant argues that there is no reasonable expectation of success. However, both references are drawn to ink compositions, JP '275 teaches all the components except for the presence of the microbeads or flakes. Rizika teaches incorporating the microbeads into the composition. Therefore, one of ordinary skill in the art would have known from Rizika that reflective microspheres can be used in ink compositions, and therefore would have had a reasonable expectation that such microspheres could be incorporated into the ink composition of JP '275 with similar results.

8. Applicant argues that all claim limitations are not taught. However, since JP '275 teaches the claimed coupling agent, it is reasonable to presume that the coupling agent of JP '275 would have and impart the same properties to the ink composition as the instantly claimed coupling agent. Whether JP '275 calls the blocked isocyanate a coupling agent or not, since JP '275 discloses the same materials being used to make an ink, JP '275 meets the claim. Applicant argues that JP '275 does not teach the same composition as the claimed composition but that they are in fact different chemical compositions. However, the claims recite a binder and a particular coupling agent. JP '275 discloses a binder and the particular coupling agent. If the compositions are different, the claims as currently written do not reflect the difference, and therefore, the rejection is maintained.

9. With regard to claim 62, Applicant argues that Yoshida does not teach a binder to microbead ratio of less than 50%. However, Yoshida teaches employing microbeads in

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an amount of less than 50%. Further, since the microbeads are added to provide a particular appearance to the ink it would have been obvious to one of ordinary skill in the art to have optimized the relative proportions of the microbeads relative to the other components of the ink composition in order to optimize the appearance, strength, durability of the ink.

10. With regard to claims 63, 69, 82-105, 115 and 117, Applicant argues that these claims are patentable for the reasons advanced with regard to the combination of JP '275 and Rizika. The rejections are maintained for the reasons set forth above.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

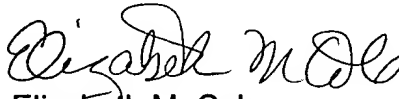
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.

  
Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c